

### **REMARKS**

Claims 1-3, 5, 8-23, 25 and 27-70 are pending in the above-captioned patent application after this amendment. As set forth in the Interview Summary below, claims 4, 6, 7, 24 and 26 had been previously canceled in Amendment and Response to Office Action dated July 16, 2001. Claims 1-3, 5, 8-23, 25 and 27-60 have been rejected. The Applicants respectfully traverse the rejection of claims 1-3, 5, 8-23, 25 and 27-60. Further, claim 39 has been amended to correct an obvious typographical error, and new claims 61-70 have been added by this amendment for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000).

Support for the amendment to claim 39 and to the new claims can be found throughout the originally filed specification, in the drawings and in the claims. More specifically, support for new claims 61-70 can be found at least in Figures 3-19, and in the specification at page 8, line 11 through page 16, line 31.

No new matter is believed to have been added by this amendment. Consideration of the Application is respectfully requested.

### **Interview Summary**

On February 24, 2003, the undersigned attorney for the Applicants conducted a telephonic interview with the Examiner, Dan Jenkins. During the interview, the undersigned indicated that although the Office Action dated February 19, 2003, states that claims 1-60 were pending, claims 4, 6, 7, 24 and 26 had previously been canceled in the Amendment and Response to Office Action dated July 16, 2001. As a result of this communication, the Examiner stated that the previous cancellation of claims 4, 6, 7, 24 and 26 should be mentioned in the instant response, and that no further action in this regard was required.

Further, on March 6, 2003, the undersigned conducted a telephonic interview with Examiner Jenkins. Prior to the interview, a draft Amendment and Response was faxed to the Examiner for review. During the interview, the

proposed claims as provided herein were discussed. The Examiner indicated that the claims appeared to be in condition for allowance, however, additional research was required before the claims would be allowed. In addition, the Examiner indicated that once a decision had been made he would contact the attorneys for the Applicants.

Moreover, on March 12, 2003, Steven G. Roeder, attorney for the Applicants received a telephone call from Examiner Dan Jenkins. During the telephone call, Examiner Jenkins stated that the proposed arguments and proposed draft claims placed the application in condition for allowance. Further, the Examiner stated that the proposed Amendment and Response should be filed by facsimile. The Applicants wish to thank the Examiner for his time and effort during the interviews.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1-3, 5, 8-23, 25 and 27-60 are rejected under 35 U.S.C. § 112, second paragraph, as being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term 'substantially' renders the pending claims indefinite." Applicants respectfully traverse the rejection of the Patent Office for the reasons which follow.

First, the term "substantially" does not appear in each of the rejected claims. For example, at least claims 11, 19, 20, 27-34, 39 (as amended), 42 and 52 do not include the term "substantially". Consequently, there is no reasonable basis for rejecting these claims. Therefore, the rejection of claims 11, 19, 20, 27-34, 42 and 52 under 35 U.S.C. § 112, second paragraph, should be withdrawn, and these claims should be allowed. Moreover, claim 39 has been amended to correct a typographical error, and now depends from claim 34 which does not include the term "substantially". Thus, the rejection of claim 39 is believed to have been overcome.

Additionally, the Applicants respectfully submit that usage of the term "substantially" does not render the claims indefinite. 35 U.S.C. § 112, second paragraph, contains two separate and distinct requirements, namely, (A) the

claims must set forth the subject matter that applicants regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. MPEP § 2171.

To interpret whether these criteria have been satisfied, MPEP § 2173.02 provides guidelines to be followed by the Patent Office. MPEP § 2173.02 states in relevant part:

"When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." (Emphasis original and added.) MPEP § 2173.02.

In addition to the claims identified above that do not include the term "substantially", pending claims 1-3, 5, 8-10, 12-18, 21-23, 25, 35-41, 43-51 and 53-60 define the patentable subject matter with a reasonable degree of particularity and distinctness notwithstanding the usage of the term "substantially" in conjunction with the terms "parallel" and "transversely". In compliance with the MPEP, latitude in the manner of expression should be permitted.

Further, case law supports the usage of the term "substantially". For example, in Andrew Corporation v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010, the U.S. Court of Appeals for the Federal Circuit *reversed* the District Court's ruling that a patent was invalid for indefiniteness. The Court of Appeals held that the patent was not invalid, even though the applicant used words such as "approach each other", "close to", "substantially equal" and "closely approximate". The court relied on Seattle Box Co. v. Industrial Crating & Packing, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1983), which remarked that "substantially equal" is a term of degree, and that its acceptability depends on "whether one of ordinary skill in the art would understand what is claimed ... in light of the specification, even if experimentation may be needed."

A review of the specification of the issued patent shows that no guidance or definition for "substantially" was provided. (See U.S. Patent No. 4,410,892 issued to Knop, et al.) Nevertheless, the court found that the term "substantially" was found not to be indefinite. (See also, In re Mattison, 509 F.2d 563, 184 USPQ 484 (1975); U.S. Patent No. 3,939,203 issued to Mattison, et al., wherein no definition of the term "substantially" is provided in the specification.)

Additionally, as summarized by the Second Circuit Court of Appeals, "If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." Georgia Pacific Corp. v. United States Plywood Corp., 258 F.2d 124, 136, 118 USPQ 122, 132 (2d Cir.), cert. Denied, 358 U.S. 884, 79 S.Ct. 124 (1958). (Emphasis added.)

Based on the foregoing reasons, the Applicants respectfully request that the Patent Office withdraw its rejection of claims 1-3, 5, 8-23, 25 and 27-60 under 35 U.S.C. § 112, second paragraph, and that these claims be allowed.

#### **NEW CLAIMS**

New claims 61-70 have been added by this amendment pursuant to the suggestion of the Patent Office. New claims 61-70 are of a slightly different scope than the previously pending claims. However, new claims 61-70 are believed to be patentable in view of the cited references.

New claim 61 is directed toward a "manufacturing fixture ... comprising: an upper punch; a lower punch; a fixture body positioned between the upper punch and the lower punch, the fixture body defining a fixture cavity that receives the magnet powder; and an orientating device that is at least partially positioned directly between the upper punch and the lower punch, the orientating device creating a magnetic field having flux lines that extend through the fixture cavity, wherein a portion of the flux lines in the fixture cavity are angled relative to the first region axis when the magnet is in the fixture cavity." These features are not taught or suggested in the cited references. Therefore, claim 61 is believed to be

patentable. Because claims 62-70 depend directly or indirectly from claim 61, they are likewise believed to be patentable.

**Version with markings to show changes made:**

**In the Specification:**

The paragraph beginning at page 12, line 25 has been amended as follows:

The magnet powder 48 is preferably formed into the magnet body 46 in the manufacturing fixture 11 utilizing powder metallurgy processes. Referring to Figure 19, the manufacturing fixture 11 includes a fixture body 100 which defines a fixture cavity 102, an upper punch 104, a lower punch 106 and an orientating device 108. The upper punch 104 and lower punch 106 are movable relative to each other to compress the magnet [power] powder 48 (not shown in Figure 19) in the fixture cavity 102, while the orientating device 108 orientates the magnetic powder 48. In the embodiment illustrated, the fixture cavity 102 is arched or curved shaped. In a typical powder metallurgy process, the magnet powder 48 (not shown in Figure 19) is initially added to the fixture cavity 102. Subsequently, the magnet powder 48 is compressed in the fixture cavity 102 with the upper punch 104 and lower punch 106 to form a pressed magnet body 46 (not shown in Figure 19). Next, the magnet body 46 is removed from the fixture cavity 102 and heated.

**In the Claims:**

Claim 39 was amended as set forth below:

39. (First Amended) The method of claim [35] 34 wherein the step of creating flux lines includes creating flux lines in the fixture cavity near a cavity perimeter which are angled relative to the first region axis.

In addition, new claims 61-70 have been added.

**CONCLUSION**

In conclusion, Applicants respectfully assert that claims 1-3, 5, 8-23, 25 and 27-70 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-456-1951 for any reason that would advance the instant application to issue. Dated this 13<sup>th</sup> day of March, 2003.

Respectfully submitted,



---

JAMES P. BRODER  
Attorney for Applicants  
Registration No. 43,514

THE LAW OFFICE OF STEVEN G. ROEDER  
5560 Chelsea Avenue  
La Jolla, California 92037  
Telephone: (858) 456-1951